

**PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In Re Application of: Jeffrey Jackson

Group Art Unit: 3632

Serial No.: 10/816,097

Examiner: Tan Le

Filed: 04/01/2004

Docket No. 17264-6102

For: Apparatus for Displaying Ornamental Objects

**RESPONSE AND AMENDMENT**

Mail Stop AMENDMENT  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

The Office Action mailed 03/19/2007 has been carefully considered. In response thereto, and in response to the communication from the patent office mailed 7/30/07, please enter the following amendments and consider the following remarks.

**Amendments to the Specification** begin on page 2 of this paper.

**Amendments to the Claims** are reflected in the listing of claims, which begins on page 3 of this paper

**Remarks/Arguments** begin on page 8 of this paper.

## AMENDMENTS

Please amend the application as indicated hereafter.

### In the Specification

Please amend the specification at Page 4, Line 16 (Paragraph 0015) as follows;

FIG. 5 is a schematic diagram, illustrating garland set upon a mantle via use of a support, in accordance with a first second embodiment of the invention.

### **In the Claims**

Please amend claim(s) 9, 14, 18, 19, 21, and 22.

Claims 1-2, 6-8, and 16 were previously cancelled.

Claims 3-5, 10, 12, and 17 were previously withdrawn.

This listing of claims will replace all prior versions, and listings, of claims in the application.

### **Listing of Claims:**

1. – 2. (Previously Cancelled)

3. (Previously Withdrawn) The apparatus of claim 1, wherein said central loop further comprises an open back portion that allows said second object to be placed within said central loop, wherein said open back portion holds to said structure.

4. (Previously Withdrawn) The apparatus of claim 1, wherein said holding portion is formed to fit a banister.

5. (Previously Withdrawn) The apparatus of claim 1, wherein said holding portion has a shape similar to a shape of said structure, so that said holding portion at least partially fits snugly on said structure.

6. – 8. (Previously Cancelled)

9. (Currently Amended) An apparatus for displaying an object on a structure having a horizontal planar surface, said apparatus comprising:

a holding portion shaped so as to allow said apparatus to hold to said structure by an interior underside portion of said holding portion being capable of resting only on said structure horizontal planar surface;

a frictional element affixed to said underside portion and positioned on-said holding portion to be in contact only with said structure horizontal planar surface

whereby said frictional element reduces mobility of said holding portion along said structure horizontal planar surface;

an enclosed central loop enclosed on a top portion, a bottom portion, a front portion, and a back portion of said enclosed central loop, said back portion of said enclosed central loop being a portion of said holding portion, and said enclosed central loop being open on a left side portion and a right side portion of said enclosed central loop;

a hook being an extension of said back portion of said enclosed central loop, said hook being capable of allowing said object to be set on said apparatus; and

wherein said enclosed central loop is capable of allowing a second object to be situated in said enclosed central loop after being placed within said left side portion or said right side portion.

10. (Previously Withdrawn) The apparatus of claim 9, wherein said apparatus is fabricated from a shape conforming material so that said apparatus may be flexed out of an original shape when a force is provided to said holding portion, and said apparatus returns to said original shape when said force is removed.

11. (Original) The apparatus of claim 9, wherein said frictional element further comprises a two-sided adhesive tape.

12. (Previously Withdrawn) The apparatus of claim 9, wherein said holding portion has a shape similar to a shape of a banister.

13. (Previously Presented) The apparatus of claim 9, wherein said holding portion has a shape that is adapted to rest on a mantle.

14. (Currently Amended) The apparatus of claim 9, wherein said hook ~~does not contact~~ is shaped to avoid contact with said structure when said apparatus holds said structure holding portion rests on said horizontal planar surface.

15. (Original) The apparatus of claim 9, wherein said frictional element further comprises a thin, rubber pad.

16. (Previously Cancelled)

17. (Previously Withdrawn) The support of claim 16, wherein said means for holding has a shape similar to a shape of said structure, so that said means for holding at least partially fits snugly on said structure.

18. (Currently Amended) The apparatus of claim 21, wherein said means for hanging extends from said means for holding and wherein said means for hanging ~~does not contact~~ is shaped to avoid contact with said structure when said ~~apparatus holds said~~ structure holding portion rests on said horizontal planar surface.

19. (Currently Amended) The ~~support~~ apparatus of claim 21, wherein said means for gripping further comprises an adhesive.

20. (Previously Presented) The apparatus of claim 9, wherein said holding portion contains an elongated top portion and an elongated side portion, said elongated side portion extending in a direction substantially perpendicular to said elongated top portion, a portion of said elongated side portion being said back portion of said enclosed central loop.

21. (Currently Amended) An apparatus for displaying an object on a structure having a horizontal planar surface, said apparatus comprising:

means for holding only to said ~~structure~~ horizontal planar surface;

means for gripping for enhancing the grip of said means for holding ~~on~~ only to said ~~structure~~ horizontal planar surface;

means for maintaining a second object in said apparatus, said means for maintaining being enclosed on a top portion, a bottom portion, a front portion, and a back portion, said back portion of said means for maintaining being a portion of said means for holding, and said means for maintaining being open on a left side portion and a right side portion of said means for maintaining; and

means for hanging being capable of allowing a first object to hang from said apparatus, said means for hanging being an extension of said back portion of said means for maintaining a second object in said apparatus,

wherein said means for maintaining is capable of allowing said second object to be situated in said means for maintaining after being placed within said left side portion or said right side portion.

22. (Currently Amended) An apparatus for displaying an object on a structure having a horizontal planar surface, said apparatus comprising:

a holding portion shaped so as to allow said apparatus to hold to said structure by an interior underside portion of said holding portion being capable of resting only on said structure horizontal planar surface, said holding portion having an elongated top portion and an elongated side portion, said elongated side portion extending in a direction substantially perpendicular to said elongated top portion;

a frictional element affixed to said underside portion and positioned ~~on said holding portion~~ to be in contact only with said structure horizontal planar surface whereby said frictional element reduces mobility of said holding portion along said structure horizontal planar surface;

an enclosed central loop, enclosed on a top portion, a bottom portion, a front portion, and a back portion of said enclosed central loop, a portion of said elongated side portion being said back portion of said enclosed central loop, and said enclosed central loop being open on a left side portion and a right side portion of said enclosed central loop; and

a hook having a top portion and a bottom portion, said hook being an extension of said back portion of said enclosed central loop and therefore an extension of said

elongated side portion of said holding portion, said hook being capable of allowing said object to be set on said apparatus, and said top portion of said hook extending in a direction that is not perpendicular to said elongated top portion and not parallel to said side portion of said holding portion.

## REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed 03/19/2007. Reconsideration and allowance of the application and presently pending claims, as amended, are respectfully requested.

### 1. Present Status of Patent Application

Upon entry of the amendments in this response, claims 9, 11, 13-15, and 18 - 22 remain pending in the present application. More specifically, claims 9, 14, 18, 19, 21, and 22 are directly amended; claims 1, 2, 6-8, and 16 are cancelled without prejudice, waiver, or disclaimer; and claims 3-5, 10, 12, and 17 are withdrawn. These amendments are specifically described hereinafter. It is believed that the foregoing amendments add no new matter to the present application.

### 2. Examiner Interview

Applicant first wishes to express his sincere appreciation for the time that Examiner Tan Le spent with Applicant's Representative during a telephone discussion on 06/05/2007 regarding the outstanding Office Action. Applicant believes that certain important issues were identified during the telephone discussion, and it is Applicant's understanding that the amendments herein resolve those issues and conform to the Examiner's recommendations. Thus, Applicant respectfully requests that Examiner carefully consider this response and the amendments.

### 3. Miscellaneous Issues

Additional to those issues raised in the Office Action and discussed in the telephonic interview, Applicant has noticed two typographical errors in the application, which are addressed by the foregoing amendments to the Specification and to claim 19. No new matter has been added by these amendments.



#### 4. Response To Claim Rejections Under 35 U.S.C. Section 112, Second Paragraph

In the Office Action, Claims 14 and 18 are rejected under 35 USC 112, Second Paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as his invention. The Examiner states that the phrase “when said apparatus holds said structure” is confusing and unclear.

Claim 14 has been amended to more accurately conform to the language of amended claim 9, from which claim 14 depends, specifically, it is now stated that “said holding portion rests on said horizontal planar surface” (of said structure). With this amendment, together with the related amendment to claim 9 discussed below, it is believed that this rejection is overcome and should be removed.

Claim 18 has been amended to more accurately conform to the language of amended claim 21, from which claim 18 depends, specifically, it is now stated that “said holding portion rests on said horizontal planar surface” (of said structure). With this amendment, together with the related amendment to claim 21 discussed below, it is believed that this rejection is overcome and should be removed.

In the Office Action, the Examiner states that the language of the phrases “wherein the hook does not contact said structure” of claim 14 and “wherein said means for hanging does not contact said structure” of claim 18 are not “consistent with the intent” (of the invention). In the telephone discussion, the Examiner explained that these phrases form “unacceptable negative limitations”, and that they should be re-phrased to positively explain what the invention “does” rather than what it “doesn’t do”. Applicant believes that the amendment of these phrases to now state that the hook of claim 14 and the hanging means of claim 18 are “shaped to avoid contact with said structure” provides the positive language suggested by the Examiner and that this rejection should now be removed.

#### 5. Response To Claim Rejections Under 35 U.S.C. Section 102

In the Office Action, claims 9, 13, and 20 are rejected under 35 USC 102 as being anticipated by USP 2743023 to Larson. The Examiner states that Larsen teaches, among other things, “a frictional element positioned on said holding portion to be in contact with

said structure whereby said frictional element reduces mobility of said holding portion along said structure”.

In the telephone discussion, the examiner stated that “other frictional elements, such as screws, adhesive, or even welding are well known and equivalents to the frictional elements of the invention”. The examiner further stated that the screws of Larson’s figures 7-9 are “frictional elements” within the normal definition of such a term.

While the Applicant strongly disagrees with this interpretation of the phrase “frictional element”, it is believed that this issue is mooted for independent claim 9 by the amendment thereto wherein the frictional element is now required to be “**affixed to said underside portion** and positioned to be in contact **only** with said horizontal planar surface”, thereby distinguishing over even such a broad interpretation of “frictional element” as when considered to encompass the screws of Larsen. It is therefore believed that this rejection should now be removed for amended claim 9.

If independent claim 9 is allowable over the prior art of record, then its dependent claims 13 and 20 are allowable as a matter of law, because these dependent claims contain all features/elements/steps of their independent claim 9. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). Additionally and notwithstanding the foregoing reasons for the allowability of claims 13 and 20, these dependent claims recite further features/steps and/or combinations of features/steps (as is apparent by examination of the claims themselves) that are patentably distinct from the prior art of record. It is therefore believed that this rejection should now be removed for claims 13 and 20.

In the Office Action, claim 21 is rejected under 35 USC 102 as being anticipated by USP 2743023 to Larson. It is believed that this rejection is overcome by the amendment to claim 21 wherein the means for gripping is now required to be “**holding only to said horizontal planar surface**”, and that this rejection should now be removed for amended claim 21.

#### 6. Response To Claim Rejections Under 35 U.S.C. Section 103

In the Office Action, Claims 11, 15, and 19 are rejected under 35 USC 103(a) as being unpatentable over Larson in view of USP 685452 to Hamerski.

Because independent claim 9 as amended is now believed allowable over the prior art of record for the reasons stated above, its dependent claims 11 and 15 are allowable as a matter of law, for at least the reason that these dependent claims contain all features/elements/steps of their independent claim 9. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988), and this rejection of claims 11 and 15 is thereby mooted. Additionally and notwithstanding the foregoing allowability of these dependent claims, claims 11 and 15 recite further features and/or combinations of features, as is apparent by examination of the claims themselves, that are patentably distinct from the prior art of record. This rejection should therefore be withdrawn for claims 11 and 15.

Because independent claim 21 as amended is now believed allowable over the prior art of record, its dependent claim 19 is allowable as a matter of law, for at least the reason that this dependent claim contains all features/elements/steps of its independent claim 21. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988), and this rejection of claim 19 is thereby mooted. Additionally and notwithstanding the foregoing allowability of this dependent claim, claim 19 recites further features and/or combinations of features, as is apparent by examination of the claim itself, that are patentably distinct from the prior art of record. This rejection should therefore be withdrawn for claim 19.

#### 7. Prior Art Made of Record

The prior art made of record has been considered, but is not believed to affect the patentability of the presently pending claims.

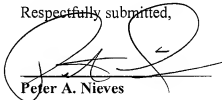
#### 8. Communication From The Patent Office Mailed July 30, 2007

In accordance with the request of the patent office, the claims have been placed on a separate sheet.

### CONCLUSION

In light of the foregoing amendments and for at least the reasons set forth above, Applicant respectfully submits that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the now pending claims 9, 11, 13-15, and 18 - 22 are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (603) 627-8134.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Peter A. Nieves', is written over a horizontal line. The signature is stylized with loops and a long horizontal stroke extending to the right.

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### AUTHORIZATION TO DEBIT ACCOUNT

It is not believed that extensions of time or fees for net addition of claims are required, beyond those which may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefore (including fees for net addition of claims) are hereby authorized to be charged to deposit account no. 501304.